

REMARKS

The Office Action dated March 18, 2009, has been received and the Examiner's comments carefully considered.

The present Amendment modifies claims 1, 3, 7, 12, 15, 17, and 20, all in accordance with the originally-filed specification. No new matter has been added. Support for these amendments can be found, for example, in paragraph [0005] and Fig. 4 in the originally-filed specification. Further, claims 2 and 16 have been cancelled, without prejudice. Accordingly, claims 1, 3-15, and 17-21 are pending in this application.

Claims 1, 2, 6, 9-16, 20, and 21 stand rejected under 35 U.S.C. §103(a) for obviousness over U.S. Patent No. 5,167,739 to Hutchinson et al. (hereinafter "the Hutchinson patent") in view of U.S. Patent No. 6,386,771 to Haller (hereinafter "the Haller patent"), and U.S. Patent No. 7,236,258 to Wen et. al. (hereinafter "the Wen patent"). Claims 3-5, 7, 8, and 17-19 stand rejected under 35 U.S.C. §103(a) for obviousness over the Hutchinson patent in view of the Haller patent, the Wen patent, and Fig. 1 of Applicants' admitted prior art.

Summary of the Preferred Embodiments

As set forth in independent claim 1, as amended, provided is a method for forming a document set, said document set formed from rectangular sheets of the same size and including only one single envelope sheet and at least one insert sheet, the method including: printing said single envelope sheet with envelope information, said envelope information including a unique code identifier to identify said single envelope sheet; printing each of said at least one insert sheets with insert information, said insert information including a further unique code identifier to identify each of said at least one insert sheets, wherein the unique code identifier of said single envelope sheet is unique from the further unique code identifier of each of said at least one insert sheets; collating said single envelope sheet and at least one insert sheet by reading the unique code identifier of said single envelope sheet and the further unique code identifier of each of said at least one insert sheets

to form said document set; and verifying said document set by performing a self-referencing integrity check on the read unique code identifier of said single envelope sheet and the read further unique code identifier of each of said at least one insert sheets.

As set forth in independent claim 12, as amended, provided is a method for forming a document set, said document set formed from rectangular sheets of the same size and including only one single envelope sheet and at least one insert sheet, the method including the steps of: applying an adhesive layer to at least one side of said single envelope sheet in a predetermined pattern, said pattern arranged to provide adhesive means for an envelope formed from said single envelope sheet when said envelope from said single envelope sheet is re-used; printing said single envelope sheet with envelope information, said envelope information including a unique code identifier to identify said single envelope sheet; printing each of said at least one insert sheets with insert information, said insert information including a further unique code identifier to identify each of said at least one insert sheets, wherein the unique code identifier of said single envelope sheet is unique from the further unique code identifier of each of said at least one insert sheets; collating said single envelope sheet and at least one insert sheet by reading the unique code identifier of said single envelope sheet and the further unique code identifier of each of said at least one insert sheets to form said document set; and verifying said document set by performing a self-referencing integrity check on the read unique code identifier of said single envelope sheet and the read further unique code identifier of each of said at least one insert sheets.

As set forth in independent claim 15, as amended, provided is an apparatus for forming a document set, said document set formed from rectangular sheets of the same size and including only one single envelope sheet and at least one insert sheet, said apparatus including: a printer for printing said single envelope sheet with envelope information, said envelope information including a unique code identifier to identify said single envelope sheet and furthermore for printing each of said at least one insert sheets with insert information, said insert information including a further unique code identifier to identify each of said at least one insert sheets, wherein the unique code identifier of said single envelope sheet is unique from the further unique code identifier of each of said at least one insert sheets; a scanner for scanning the unique code identifier of said single envelope sheet and the further unique code identifier of each of said at least one insert sheets; a collator for collating said

single envelope sheet and at least one insert sheet in accordance with the scanned unique code identifier of said single envelope sheet and the scanned further unique code identifier of each of said at least one insert sheets to form said document set; and a data processor to process said scanned unique code identifier and said scanned further unique code identifier of each of said at least one insert sheets and perform a self-referencing integrity check, thereby verifying the document set.

The cited prior art

The newly cited Wen patent discloses a method for producing personalized greeting cards. The ordered greeting cards are produced in batches and a batch-separation symbol is printed on at least one greeting card in each batch. The greeting cards produced are separated into batches using the batch-separation symbols. More specifically, the Wen patent is concerned with forming batches of single greeting cards which later must be individually matched with envelopes. Printed on the greeting card is a machine readable signal (520) whose contents are not specified but which is said to be cross-referenced against the visual symbol (510) and the serial number (530) (see Col. 9.65-10.3). After sorting of the greeting cards into separate batches, each individual batch is checked by an operator who scans the machine readable code (520) of the first and last greeting card of the batch as identified by the relevant batch-separation symbol (510). This scanning process causes information for each of these cards to be extracted from a database and this information is compared to confirm the batch number for each of these cards in a verification stage. Specifically, a check must be performed via information obtained from an external data source (see Col. 10.26-48, the Wen Patent). Where the greeting cards are to be sent as direct-mail cards, envelopes are subsequently printed for the whole batch of greeting cards (see Figure 4 – step 460 and Col 11.64-66). Each envelope is printed with a serial number (720) that is stated to match the last two digits of the greeting card serial number of the envelope (530) so that the direct-mail card and the corresponding envelope can be matched (see Col. 12.4-7). Similarly, the envelope can be printed with a barcode (740) whose contents while otherwise not specified may include information about the matching greeting card so that scanning of barcode (740) on the envelope and the scanning of barcode (520) on the greeting card can confirm correct matching of an envelope and a direct-mail card.

The Hutchinson patent is directed to a method of forming a multi page mailer type business from three different sheets, a top sheet (10), a middle sheet (12), and a bottom sheet (13). The top and bottom sheets (10, 13) are manufactured simultaneously with perforations inside of perimeter areas of three of the edges. The sheets (10, 12, 13) are provided in a vertical stack into a laser printer (67), first printing the top sheet (10), the middle sheet (12), and then the bottom sheet (13). The printer (67) prints machine readable identification information in the form of a bar code (69) on each of the sheets (10, 12, 13) that are to be provided in a final mailer (78).

The Haller patent discloses a method for manufacturing mailing-ready printed products. More specifically, the envelope for the mailing-ready printed product is produced from at least one printed sheet folded so as to form an envelope without producing waste portions.

Improper Combination of References

It is respectfully submitted that the Examiner has not identified why a person skilled in the art would combine the Wen patent, given its focus on matching individual cards from a batch of cards to standard closed face envelopes, with the Hutchinson patent and the Haller patent which are directed toward forming a unitary mail item. As previously stated, the Wen patent is a system for batch processing of direct-mail items consisting of a single greeting card and a standard envelope. The "document set" is formed in two distinct stages including (1) a batch forming and verification stage of individual greeting cards and (2) an envelope matching stage. The greeting cards in the Wen patent are printed in a continuous process and require separation into discrete batches (see Col. 9.17-21). This separation process is facilitated using batch-separation symbols (510) which are printed on the greeting cards, in addition to what is termed as a unique alpha-numeric serial number 530 comprising an order number, the batch number, the number of greeting cards within a batch, and the sequence number of the greeting card within a batch (see Col. 9.40-56).

There is no reason or motivation to combine the Wen patent with the Hutchinson and Haller references in a manner that results in the recited invention. As part of a *prima facie* case, an Examiner must establish some reason to combine the references. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007); *Takeda Chemical Industries, Ltd. v. Alpharpharm Pty., Ltd.*, 492 F.3d 1350, 1356-1357 (Fed. Cir. 2007). The *KSR* Court

acknowledged the importance of identifying a reason that would have prompted a person of ordinary skill in the art to combine the elements in the way the claimed invention does. *KSR Int'l*, 127 S.Ct. at 1731; *Takeda Chemical*, 492 F.3d at 1356-1357. Repeatedly throughout the *KSR* decision, the Court discussed the importance that the result obtained by a particular combination was predictable to one of ordinary skill in the art. *KSR Int'l*, 127 S.Ct. at 1731 and 1739-1742. Mere conclusory statements are insufficient to establish the requisite reason to combine. See MPEP § 2141, citing *In re Kahn* 441, F.3d 977, 988 (Fed. Cir. 2006).

The Examiner states in the office action that "it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the envelope and the insert sheet in the method of the Hutchinson patent, as modified by the Haller patent with the unique code identifier for the envelope that contains information about the insert sheet but is unique to the unique code identifier for the insert sheet as taught by the Wen patent as simply an equivalent way to predictably achieve the same envelope and insert matching process via the scanning process." The Hutchinson patent has common identification codes applied to all sheets, including the envelope sheet, comprising a document set, because the Hutchinson patent is a method of forming a multi-page mailer. The Hutchinson patent actually teaches away from the Wen patent because it (1) teaches a process where multi-page inserts are formed of three sheets and (2) the same common identifier is used on all three sheets of a set. Accordingly, Applicants respectfully submit that a person skilled in the art having already combined the references of the Hutchinson patent and the Haller patent creating a process to form a multipage mailer, would not then reasonably combine the further disclosure of the Wen patent which is concerned with a completely different two-step process for forming a direct-mail item.

Therefore, due to the lack of the requisite reason to combine these references, the rejection based on the combination of references is not proper. Withdrawal of the rejection and allowance of the pending claims are therefore respectfully requested.

Obviousness Rejections of Independent Claims 1, 12, and 15

Assuming arguendo the combination of the Hutchinson patent, the Haller patent and the Wen patent is proper, it still fails to teach each and every limitation of newly amended claim 1. The Examiner has admitted in the office action that the Hutchinson patent and the Haller patent do not teach the use of unique code identifiers for multiple cards or

inserts. However, the Wen patent fails to cure this deficiency. The Wen patent only describes matching batches of single inserts with envelopes and does not teach unique code identifiers for multiple cards or inserts.

Also, amended independent claim 1 includes the limitation originally recited in claim 2 that the document set consisting of the envelope sheet and at least one sheet is verified by performing a self-referencing integrity check on the unique code identifier of the single envelope sheet and the further unique code identifier of each of said at least one insert sheets. Accordingly, the present invention is directed to a document set which prior to the formation of any associated mail out item has been verified by a self-referencing integrity check performed on the contents of the document set. The verification check of the Wen patent is not a self-referencing integrity check as claimed in claim 1 of the present invention, but is a comparison made with external information. The comparison is performed by an operator checking each individual batch and then scanning the machine readable code of the first and last greeting card of a batch to extract information from a database.

Similarly, in the matching process of the Wen patent, between a direct-mail card and a corresponding envelope, the barcode (740) of the envelope could be identical to the machine readable signal (520) to achieve this purpose as it is not necessary to uniquely identify the envelope as an envelope from the greeting card given its different physical form (i.e. it is apparent to an operator of the system that an envelope is an "envelope"). The Wen patent is silent on any application other than the use of standard closed face envelopes and there is no teaching towards uniquely identifying multiple elements of a document set and the importance of this unique identification in the ability to perform a self-referencing integrity check to verify the document set. It is therefore respectfully submitted that the combined disclosures of the Hutchinson, Haller, and Wen patents fail to disclose or teach each and every limitation of claim 1.

In summary, Applicants respectfully submit claim 1 is patentable because the combination of documents is improper and even if the documents were so combined, the Wen patent teaches away from the present invention as it relates to a distinct two stage process each involving separate verification procedures and does not teach or suggest a unique code identifier for multi-sheet mailers nor the streamlined self-referencing verification procedure of the present invention.

Claims 6 and 9-11 depend from and add further limitations to independent claim 1 and are believed to be patentable for the reasons discussed hereinabove in connection with claim 1.

Independent claim 12 has been similarly amended as claim 1 with claim 12 now incorporating the limitations of claim 2. It is believed that independent claim 12 is in condition for allowance for the reasons stated hereinabove with regard to claim 1.

Independent claim 15 has been similarly amended as claim 1 and now includes the limitations of claim 16. It is believed that independent claim 15 is in condition for allowance for the same reasons stated hereinabove with regard to claim 1. Claim 16 depends from and adds further limitations to independent claim 15 and is believed to be allowable for the same reasons discussed hereinabove in connection with claim 15.

Claims 3-5, 7, 8, and 17-19 stand rejected under 35 U.S.C. 103(a) for obviousness over the Hutchinson patent in view of the Haller patent and the Wen patent, as applied to claims 1, 2, 12, 15, and 16, and further in view of Fig. 1 Applicants' Admitted Prior Art (AAPA). In view of the above amendments and the following remarks, the Applicants respectfully request reconsideration of these rejections.

For the heretofore mentioned reasons, it is submitted that the Wen patent teaches away from the present invention and hence does not cure the deficiencies of the combined disclosure of the Hutchinson and Haller patents. Similarly, the AAPA does not cure the deficiencies of the combined disclosures of the Hutchinson, Haller, and Wen patents. Applicants respectfully disagree with the Examiner's conclusion that the APAA teaches performing a self-referencing integrity check. The AAPA teaches only the performing of an integrity check with regard to the insert sheets and does not to teach or disclose an integrity check to the document set as a whole, including the envelope. Furthermore, the integrity check referred to in the APAA is not self-referencing as it relates specifically to a comparison between the identifier information on the insert sheets and a process data file. In no way can this be characterised as a self-referencing check since a comparison must be made with external information. For these reasons, Applicants respectfully submit that independent claims 1, 12 and 15 and associated dependent claims are patentable over the combined disclosure of the Hutchinson, Haller, and Wen patents, and the APAA.

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The pending Claims 3-5, 7, 8, and 17-19, which depend from independent claims 1, 12, and 15 are believed to be allowable for at least these reasons as well as for the reasons discussed hereinabove with regard to claims 1, 12, and 15.

CONCLUSION

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1, 3-15, and 17-21 are respectfully requested.

Respectfully submitted,

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